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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/581,715

06/28/2006

Hye-Jin Lee

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EXAMINER

HANRAHAN, JOSEPH M.J.

ART UNIT

PAPER NUMBER

1794

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/581,715	Applicant(s) LEE, HYE-JIN	
	Examiner JOSEPH M.J. HANRAHAN	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
 4a) Of the above claim(s) 5-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/5/06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 1-4 and 8-12, drawn to a method and product.

Group 2, claim(s) 5-7, drawn to an apparatus.

2. The inventions listed as Groups 1 and 2 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The two groups share a common technical feature of agitating an egg yolk and albumin while still in the egg shell. It is known in the art to agitate an egg yolk and albumin while still in the shell (Hansen US Pat. No. 2316861, Col. 2, Lines 22-27). Since the common technical feature is known in the art it is not a special technical feature and, therefore, restriction is proper.

3. In applicant's Traversal of the Requirement for Restriction filed 4/29/09 applicant has traversed on the grounds that a serious search burden does not exist and that the examiner has not met the burden of showing that the two inventions are not independent and distinct. The examiner has considered these arguments, however the

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standard which is applied in national stage entries of PCT applications is whether or not there exists a single inventive concept under PCT Rule 13.1. The examiner has conducted the restriction analysis under the PCT Rules and has reached the conclusion that restriction is warranted as outlined above. The requirement is still deemed proper and is therefore made FINAL.

4. Claims 5-7 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 4/29/09.

Specification

5. The specification is objected to. The specification does not conform to standard practice in the US. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.

(e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.

(f) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(g) BRIEF SUMMARY OF THE INVENTION.

(h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(i) DETAILED DESCRIPTION OF THE INVENTION.

(j) CLAIM OR CLAIMS (commencing on a separate sheet).

(k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

6. The specification is replete with terms which are not clear, concise and exact. 35

U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. It appears that this specification may be a translation of foreign language application. The specification should be amended to contain clear and grammatically correct English.

7. The abstract is objected to. Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. The

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language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Objections

8. The claims are objected to because they include reference characters which are not enclosed within parentheses.

Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m).

9. Regarding Claim 9, the term "injection" is grammatically incorrect. Appropriate action is required.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-4 and 8-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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12. Claim 1 recites the limitations "the upper portion," "the egg shell," the long axis," the viscous albumin" in steps b and d. There is insufficient antecedent basis for these limitations in the claim.

13. Claim 3 recites the limitation "the egg shell" in Line 4. There is insufficient antecedent basis for this limitation in the claim.

14. Claim 4 recites the limitations "the content" in Line 3, "the albumin" in Line 3, "the yolk" twice in Line 4, "the place" in Line 5, and "the content" in Line 5. There is insufficient antecedent basis for these limitations in the claim.

15. Claim 8 recites the limitations "the upper portion" in Line 3, "the long axis" in Line 3, "the contents" in Line 3, and "the form" in Line 4. There is insufficient antecedent basis for this limitation in the claim.

16. Claim 9 recites the limitations "the albumin" in Line 2 and "the egg shell" in Line 2. There is insufficient antecedent basis for these limitations in the claim.

17. Claim 12 recites the limitations "the content" in Line 2, "the albumin" in Line 2, and "the yolk" in Line 2. There is insufficient antecedent basis for these limitations in the claim.

18. Regarding Claims 1, 3, and 9, the terms "certain pressure" in claim 1 and "certain thickness" in Claims 3 and 9 are relative terms which renders the claim indefinite. The terms "certain pressure" and "certain thickness" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. One of ordinary skill in the art would not know how much pressure to use or

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how thick the albumin should be. The examiner has treated these terms to mean any pressure and any thickness.

19. Regarding Claims 1 and 3, where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “drilling” in claims 1 and 3 is used by the claim to mean “puncture”, while the accepted meaning is “boring through by a rotating element.” The term is indefinite because the specification does not clearly redefine the term.

20. Regarding Claims 2 and 8, the term “rod, spread” in is indefinite because it does not clearly define what is meant by the term “agitating means.” Furthermore, the use of 112 6th paragraph language indicates that the reader should look to the specification for the definition of the means. The inclusion of additional limitations on the means language in the claims is confusing. The examiner has treated the meaning of the term “agitating means” to be defined as an agitator that is in the form of a rod. These claims should be reworded to conform to the requirements 35 USC 112 6th paragraph.

21. Regarding Claim 2, the phrase “and/or” renders the claim indefinite because it is unclear whether the limitation(s) surrounding the phrase are part of the claimed invention. See MPEP § 2173.05(d). The examiner has treated the movement of the agitator to be rotational or upwards and downwards.

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22. Regarding Claims 4 and 12, the terms “grains or fruits including carbohydrate” and “grains including carbohydrates and fruit” are indefinite because it is not clear whether the grain or the fruit or both include carbohydrate or whether carbohydrate is intended to be a type of grain or fruit or whether the carbohydrate is intended to be added in addition to the grain or fruit. The examiner has treated this to mean that grains or fruit or carbohydrates are added.

23. Regarding Claim 8, the term "certain desired amount" is a relative term which renders the claim indefinite. The term "certain desired amount" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. One of ordinary skill in the art would not know how much edible composition to use. The examiner has treated this term to mean any amount of edible composition.

24. Regarding Claim 10, the term “with 10 volume %” is indefinite because it indicates a range without defining what the range is. The person of ordinary skill in the art would not know how much of the edible composition is contemplated. The examiner has interpreted this claim to mean that no more than 10% of the volume of the raw egg is edible composition.

25. Regarding claim 11, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

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26. Regarding Claim 12, the term “added thereto” is indefinite because it is unclear whether the grains are being added to the shell or the contents that have been removed. The examiner has interpreted this to mean that the grains could have been added to either.

Claim Rejections - 35 USC § 103

27. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

28. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

29. **Claims 1-3 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hongqi (CN Pub. No. 1209299) in view of Hebrank (US Pat. No. 6244214) and Hansen (US Pat No. 2316861).**

30. Regarding Claims 1 and 2, Hongqi teaches boiling an egg that has had a flavoring injected into it. The examiner treats boiling as being equivalent to the step of

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cleaning and sterilizing since it is well known that boiling water (high heat) is an effective means of cleaning and sterilization.

31. Hongqi further teaches using an injector to inject liquid flavoring material through an egg shell (Hongqi Abs.). Hongqi does not teach that the egg is fixedly erected or that the injection hole is formed on the end of the long axis. However, it is known to hold an egg in an erect position and inject material through a hole formed at the end of the long axis. Hebrank teaches holding an egg in a erect position and inserting an injection tube into the end of the long axis of an egg (Hebrank Fig 2; Col. 8, Line 60 – Col. 9, Line 8; Col. 9, Lines 40-44; the figure shows the orientation of the egg and the injector (25) above it, the injector is in the form of a needle or syringe with an outer guide to pierce the shell of the egg). It would have been obvious to a person of ordinary skill in the art at the time of invention to have modified the injection step taught in Hongqi with the injection taught by Hebrank to effect an injection at the end of the long axis of an egg shell and deliver material to the interior portion of an unshelled egg. The person of ordinary skill in the art at the time of invention would have been motivated to do so since this is an effective method of injecting material into an egg as it gives the ability to inject material into a specific location within the egg and holds the egg stable while being injected (Hebrank Col. 4, Lines 19-28; Col. 8, Lines 61-65).

32. Hongi teaches mixing the injected contents and the interior contents of an egg by shaking but does not say how that it is accomplished. Agitators for mixing the interior contents of an egg are known in the art. Hansen teaches an egg beater which mixes the interior portion of an egg by inserting an agitator through a hole at the end of the

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long axis of an egg at which time springs (17) extend from the blade (16) (Hansen Figs. 1 and 2; Col. 2, Lines 15-26). It would have been obvious to a person of ordinary skill in the art at the time of invention to have performed the mixing taught by Hongqi with the agitation taught by Hansen as Hansen clearly teaches an effective agitation technique that allows the contents of the egg within the shell to remain contained therein (Hansen Col. 1, Lines 4-5).

33. Regarding Claim 3, as shown by Hongqi (Abs.) it is known that heating causes the contents of an egg to coagulate. Furthermore, Hongqi teaches coagulating at the hole prior to cooking (Abs.) which, the examiner treats as equivalent to solidifying a certain thickness inwards of the shell. Since it is well known that heat causes an egg to coagulate, it would have been obvious to have performed this step at any point during the process. The motivation to do so would have been create a final product with desired characteristics such as a desired ingredient distribution or consistency.

34. Regarding Claims 8-11, the products taught therein are obvious for the same reasons that the methods of Claims 1-3 are obvious as the product is largely defined by the methods already discussed above. There are certain exceptions as outlined below.

35. Regarding Claim 10, the references used herein do not teach how much of an edible composition may or may not be added to the egg shell. However, the methods taught by Hebrank would allow the person of ordinary skill in the art to add as much or as little material as desired. It therefore would have been obvious to a person skilled in the art at the time of invention to have added no more than 10% of the volume of the

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egg to the egg shell to form an egg that has desirable characteristics such as consistency and flavor.

36. Regarding Claim 11, Hongqi teaches that flavorings are added (Abs.).

Flavorings are considered an edible spice. Additionally, it would have been obvious to one of ordinary skill to inject any known flavoring (considered an edible material) whether natural or man made for the purpose of adding desired flavoring to the egg product.

37. **Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hongqi (CN Pub. No. 1209299) in view of Hebrank (US Pat. No. 6244214) and Hansen (US Pat No. 2316861) as applied to claims 1 and 8, above, and further in view of Chikako (JP 61-141864).**

38. Regarding Claims 4 and 12, Hebrank teaches that the device taught therein can be used to add or withdraw contents to or from eggs (Col. 3, Line 67). Additionally, it is known in the art to withdraw contents including albumin and/or yolk followed by addition of edible material to the shell of the egg through a hole in the shell (Chikako JP Pub. No. 61-141864). Given the teachings of Hongqi and Hebrank as outlined above, it would have been obvious to a person of ordinary skill in the art at the time of invention to have used the injector/extractor as taught by Hebrank to execute the invention of Chikako. The motivation to have done so would have been to prepare a boiled egg containing a food material different from the egg components using known techniques and apparatus to perform the steps (Chikako, Abs.).

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39. Furthermore, Hongqi teaches the addition of flavorings to an egg (Hongqi abs.), a person of ordinary skill in the art at the time of invention would have realized that flavorings would include a sweetener such as sugar which is a carbohydrate.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSEPH M.J. HANRAHAN whose telephone number is (571) 270-7060. The examiner can normally be reached on M-F from 10:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on 571-272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JOSEPH M.J. HANRAHAN/
Examiner, Art Unit 1794

/JENNIFER MCNEIL/

Supervisory Patent Examiner, Art Unit 1794